



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO. 8	FILED DATE 10/11/98	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
		MENARD	D 1948-4293USI

☐ MORGAN & FINNEGAN
345 PARK AVENUE
NEW YORK NY 10154

IM52/1010

EXAMINER
SINGH, A

ART UNIT	PAPER NUMBER
1771	24

DATE MAILED: 10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/041,538

Applicant(s)
Menard et al.

Examiner
Ms. Arti R. Singh

Art Unit
1771



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 Jul 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-18, 20, 22-25, and 27-39 is/are pending in the application.
- 4a) Of the above, claim(s) 12-18, 20, 22-24, 27, and 29-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11, 25, 28, and 33-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 1771

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/30/2001 has been entered.
2. The Examiner has carefully considered Applicant's amendments and accompanying remarks filed on 07/30/200. Applicant's amendments to claims 1, 9, 10, 11 & 28, and the addition of new claims 33-39 have been entered. Applicant's arguments are not found to be persuasive. The status of the claims in the instant Application are as follows: Pending-1-7, 9-18, 20, 22-25, 27-32, & 33-39. Withdrawn or Canceled by Applicant: 8, 19, 12-18, 20-24, 26, 27 & 29-32, Rejected: 1-7, 9-11, 25, 28 & 33-39.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-7, 9-11, 25, 28 & 33-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In independent claims 1 & 33 the range percentages claimed do not add up to 100%. You would have to use a maximum of both the weight of the

Art Unit: 1771

mat and the maximum percentage of the resin to have a composite equaling 100%. If 20 % of the nonwoven fibers were used and 60% of resin was used to make the composite, what makes up the rest 20% of the composite? Is there a third component that is being claimed? Since all the dependant claims bear dependencies to claims 1 & 33 they are rejected to as being dependent upon a rejected base claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-7, 9-11, 25, 28 & 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.P. 5,646,076 to Bortz. Bortz teaches a friction controlling device made of a fiber reinforced polymer composite material produced by a nonwoven textile and plastics industries material (abstract). The length of Bortzs' fibers vary, but are usually within the range of 0.3-8 cm, which well falls into Applicant's claimed range, in claims 1, 2 and 34 (column 5, lines 4-10). Preferable fibers are aramid and glass fibers (column 7, lines 1-15). A polymeric resin binder or blend of resin solutions may be impregnated into the product. Such polymers may be phenols (phenolic alcohols also termed as resols) (column 8, lines 25-65). In column 10, lines 4-64, Bortz shows the addition of embodiments into the composite, such as fillers. These fillers may be powders (graphite) or additional fibers.

Art Unit: 1771

With regards to the claimed percentages that make up the frictional material, i.e. 20%-40% by weight a mat of nonwoven fibers and approximately 40% to 60% by weight a thermosetting resin which impregnates said fibers, the Examples in the instant patent teach one or all of the claimed ranges, but not in the same example, hence it is known for those percentages to exist. Furthermore in the technology of frictional materials it is extremely well known and also taught by the instant patent to vary the parameters of the composite keeping in mind the final use of the product. One would use a different percentage of fibers and possibly less resin to have an end product that was more abrasive. Thus a person having ordinary skill in the art at the time the invention was made would have found it obvious to have used the claimed percentages of fiber and resin in the composite of Bortz, since it has been held that discovering an optimum or workable values of a result effective variable involves only routine skill in the art hence a person having ordinary skill in the art. *See In Re Boesch, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980)*. One would have motivated to use the particular percentages to adapt the final product to a particularly desired intended use.

7. Claims 6, 7 & 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.P. 5,646,076 to Bortz as applied to claims 1-7, 9-11, 26, 28 and 33-39 above, and further in view of U.S.P. 5,823,314 to Suzuki et al. Bortz discloses what is set forth above but does not expressly teach the fillers in the form of pulps. Suzuki et al. teach a frictional material containing a fiber base material such as a natural pulp fiber as a filler. It is also well known in the art that natural fibers usually have pulps. A person having ordinary skill in the art at the

Art Unit: 1771

time the invention was made would have been motivated to have used the pulp fiber of Suzuki et al. in the frictional material of Bortz to increase the overall strength of the composite.

Response to Arguments

8. Applicant's arguments filed 07/30/2001 have been fully considered but they are not persuasive. With regards to Applicant's arguments that claim 1 is not anticipated because of the claimed percentages is correct, however the percentages were not present in the office action dated 03/27/01 and hence this point is now moot because the rejection has been changed to a rejection based on obviousness. Furthermore, as stated above in the rejection, the Bortz patent in its Examples shows many different percentage ranges in terms of the fiber and resin contents, hence modifying these percentages would depend on the end use of the frictional composite and thus modifying the percentage to a optimum working range would only involve routine skill in the art.

With regards to question as to whether the Suzuki et al. patent qualifies as prior art or not, Applicant must submit an Official Translation of the French Patent 94 03518 from which a priority of March 25, 1994 is being claimed in order to overcome the date issue. Until then the rejection is maintained.

9. Any inquiry regarding this communication or earlier communications from the Examiner should be directed to Arti Singh, whose telephone number is (703) 305-0291. The Examiner can normally be reached Monday through Friday from 8 AM to 5 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor Mr. Terrel Morris, can be reached at (703) 308-2414. A Facsimile center has been

Art Unit: 1771

established in Group 1700 on the 8th floor of Crystal Plaza 3. The hours of operation are Monday through Friday 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 305-5408. This location should be used in all instances when faxing any correspondence to Art Unit 1771. Use of the Group 1700 center will facilitate rapid delivery of materials to Examiners in Art Unit 1771.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-2351.



Ms. Arti Singh
Patent Examiner
Art Unit 1771
October 05, 2001



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700